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Andrew N. Bristow

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

THOMPSON, MICHAEL M

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 10/509,015 | Applicant(s) BRISTOW ET AL. | |
| | Examiner Michael M. Thompson | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9-27-2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In the claims the term “number verification means”, “identity verifying means”, “age verifying means” and “subscriber identifier means” appear to lack support in the specification. With respect to the “number verification means”, “identity verifying means”, “age verifying means” and “subscriber identifier means” in claims 12-22, 37 CFR 1.75(d)(1) provides, in part, that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials, or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to

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amend the specification pursuant to 37 CFR 1.75(d) and MPEP § 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element. The examiner would like clarification as to which structure, materials, or acts perform the functions as recited in the claims. No new matter should be added.

Claim Objections

2. Claim 14 is objected to because of the following informalities: It appears that Applicant has inadvertently recited a different statutory category directed to a “method” in the preamble. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. When the examiner considers the “number verification means”, “identity verifying means”, “age verifying means” and “subscriber identifier means” under sixth paragraph, the scope of the claims is unclear so as not to insure that the public is informed of the boundaries of what constitutes infringement of the patent. Furthermore, it is unclear as to what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. MPEP 2173.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008)(en banc).

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the

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involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

7. **Claims 1-11** are drawn to **a method for providing goods or services to a subscriber**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user, and calling users with any stationary device and therefor these method steps are not tied to a particular machine nor do they transform an article. To qualify as a statutory process, the claim should positively recite in the body of the claim, the particular machine to which it is tied. For example, by identifying the particular machine that accomplishes the method steps, or positively reciting the article that is being transformed.

Please note that ***nominal recitations of a particular machine in an otherwise ineligible method fail to make the method a statutory process***. See *Benson*, 409 U.S. at 70 -72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity (i.e. *Bilski*) are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a particular

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machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. Ex *parte Langemyr* (2008) and *In re Bilski*, (Fed. Cir. 2008).

Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here appears to fail this test. No new matter should be added.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-4, 6-9, 11-12, 14-15, 17-20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz (U.S. 2001/0026610).

10. **With respect to claim 1**, Katz teaches a method for providing goods or services to a subscriber of a communications network, the method including the steps of: (a) verifying a calling party number; (b) verifying the identity of the subscriber associated with the calling party number; (c) verifying the age of the subscriber; and, (d) providing the subscriber with a subscriber identifier to enable access to the goods or services. (i.e. para. [0025],[0047], [0075-0078]).

11. **With respect to claim 3**, Katz teaches the method according to claim 1, wherein step (a) includes: receiving a manually generated number from the calling party; receiving an automatically transmitted calling party number; and, matching the manually

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generated number and the automatically transmitted calling party number. (i.e. para [0075-0078]).

12. **With respect to claim 4**, Katz teaches the method according to claim 1, wherein step (b) includes: receiving manually generated data from the calling party; accessing subscriber identity data from a subscriber database of calling party numbers and associated subscriber entities; and, matching the subscriber identity data with the manually generated data. (i.e. para [0040],[0047],[0075-0078]).

13. **With respect to claim 6**, Katz teaches the method according to claim 5, wherein the database is accessible locally or remotely. (i.e. para [0038-0039], in the least shows the data collected is used later for identification in the memory cells.)

14. **With respect to claim 7**, Katz teaches the method according to claim 1, wherein step (c) includes: receiving manually generated age verification data from the calling party; accessing subscriber age verification data from a database; and, matching the subscriber age verification data with the manually generated age verification data. (i.e. abstract, para [0025], [0039], [0076]).

15. **With respect to claim 8**, Katz teaches the method according to claim 7, wherein the subscriber age verification data stored in the database includes credit card details and/or drivers license numbers. (i.e. abstract, para [0025], [0039], [0076]).

16. **With respect to claim 9**, Katz teaches the method according to claim 1, wherein the goods or services are accessed or provided via a fixed or mobile telephony network. (i.e. Figure 1 remote terminal shows at least fixed or mobile. Most telephone networks are inherently fixed or mobile.)

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17. **With respect to claim 11**, Katz teaches the method according to claim 1, wherein the goods or services are a restricted communications service. (i.e. the phone lottery system of Katz is a restricted communications service since gambling is restricted by age.)

18. **With respect to claims 12, 14-15, 17-20, and 22, these claims introduce substantially similar limitations over that of claims 1, 3-4, 6-9, 11 and are therefore rejected under a similar rational. In light of the objections and rejections as to applicant's "means" language, the claims have been interpreted to comprise essentially the same subject matter of the preceding claims.**

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 2, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Owens et al. (U.S. 6,338,140).

21. **With respect to claim 2**, Katz teaches all the limitations of method claim 1, except for explicitly reciting that the identifier in step (d) is a Personal Identification Number or PIN. Owens et al. teaches a subscriber identifier such as a PIN for use with a telephone number to provide a digital signature to the telephone number. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the identification system of Katz (i.e. para [0025]) with the PIN feature as taught by Owens et al. for the well known purpose of providing another layer of security by allowing an alternative method of confirming the callers phone number as authentic.

22. **With respect to claim 5**, Katz teaches all of the limitations of the claims except for explicitly reciting that the database is a telephone directory. Owens et al teaches a database with directory numbers for telephone networks. It would have been obvious to one or ordinary skill in the art, at the time of invention, to have allowed for the phone numbers in the database of Katz to be specifically related to a directory of numbers in a telephone network for the well known purpose of matching a particular telephone number with a caller for security, confirmatory, or call-back services. (i.e. Owens et al. at Col. 18). Furthermore, it could be argued that Katz includes an internal director that consists of telephone numbers given the broadest reasonable interpretation of the claims.

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23. **With respect to claim 10**, Katz teaches all of the limitations of claim 1 except for explicitly reciting that the goods or services are accessed or provided via the Internet.

Owens et al. teaches user authentication and access by one or more computer networks such as the internet. It would have been obvious to one of ordinary skill in the art, at the time of invention to have allowed the methods of Katz to include a well known alternative to telephone networks such as the internet, when allowing a user to login and perform tasks or participate in an age restricted communications service for the well know purpose of allowing multiple avenues of network access. (i.e. Col. 18).

Conclusion

24. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629